

REMARKS

Claims 1 and 11 have been amended. Claims 3 and 22 have been cancelled. New claim 23 has been added.

Claims 1; 4; 11; 12; and 23 remain in the application. Of these, claim 1 is the sole independent method claim.

Reexamination and reconsideration are respectfully requested in view of the amendments and the following remarks.

Claim 1 has been amended to address the rejections based upon 35 U.S.C. § 112, as follows:

(i) support for the claim element that defines “providing a tool comprising a hollow body having a distal end, the tool also comprising an extension that protrudes from the distal end and forms a platform...” is found, e.g., on Specification Page 13, lines 9 to 16 and Page 15, lines 5 to 26.

(ii) support for the claim element that defines “positioning the platform near the expandable structure, with the platform located between the expandable structure and a first region of the cancellous bone which is not to be compressed ...” is found, e.g., on Specification Page 15, lines 30 to 34.

(iii) support for the claim element that defines “forming a cavity in a second region of cancellous bone by expanding the expandable structure with the platform serving as a barrier to induce the expandable structure to expand away from the platform to compress the second region of the cancellous bone, while the first region of the cancellous bone remains substantially not compressed...” is found, e.g., on Specification Page 34, line 34 to Page 16, line 11.

(iv) the “:other” and “another region” language has been amended to define a “first region” and a “second region.”

(v) the “void” language has been amended to define a “cavity.”

The applicant believes that the claim language as previously submitted is fairly supported by the Specification as filed and did not comprise new matter. Still, applicant has made the amendments in an effort to advance prosecution and not for narrowing the claims.

The claims also stand rejected under 35 U.S.C. § 103 based upon a combination of Marchosky (US 6,582,446) and Reiley (US 5,827,289). The Examiner acknowledges that Marchosky

does not compress cancellous bone to form a cavity, but relies upon Reiley to form the combination.

Neither Marchosky nor Reiley teaches or suggests a method, as defined in amended claim 1, in which a platform is positioned between an expandable structure and a first region of cancellous bone which is not to be compressed. The Examiner considers the leading edge 26 of the Marchosky device to correspond to the “platform” as defined in the claims. This is not correct. In use, the leading edge 26 of Marchosky is not positioned between the expandable structure 108 and a region of cancellous bone. Instead, the expandable structure is positioned beyond the leading edge, to avoid contact between the leading edge 26 and the expandable structure. See Marchosky, column 5, lines 35 (emphasis added), which reads: “A protective sheath 110 which collapses to the configuration shown in FIG. 6 for passing through the bore 24 prevents the bladder 108 from contacting the leading end 26 of the cannula 20 thereby protecting the bladder from puncture. Once past the leading end 26 of the cannula 20, the protective sheath 110 fans outward as shown in FIG. 7 under the influence of pressure from the expanding bladder 108.” In Marchosky, the expandable structure is placed free of contact with the leading edge, so that it can expand in all directions. In Marchosky, the leading edge 26 is not a platform, as defined in amended claim 1, that serves as a barrier to induce the expandable structure to expand away from the platform to compress the second region of the cancellous bone, while the first region of the cancellous bone remains substantially not compressed.” Reiley, too, does not place a platform between an expandable structure and a region of cancellous bone that is not to be compressed.

That claims stand rejected under the doctrine of obviousness type double patenting over claims 1 to 13 of U.S. Patent No. 6,726,691 (the ‘691 Patent) and claim 14 of US 6,716,216 (the ‘216 Patent). Applicant respectfully traverses this rejection. The MPEP requires a side by side comparison of claims of the instant application and the claims of the ‘691 Patent and the ‘216 Patent, keeping in mind that only the claims of the referenced patents can be considered as support for the rejection, and the disclosures of the cited references are looked to only to determine the meaning of the claims. The claims of the ‘691 Patent are directed to forming a cavity with a barrier region of compressed cancerous bone substantially surrounding the cavity; filling at least a portion of the cavity with a bone filler, and inserting a cavity-forming device into the cavity and compressing at least a portion of the bone filler against the barrier region. The claims of the ‘216 Patent are

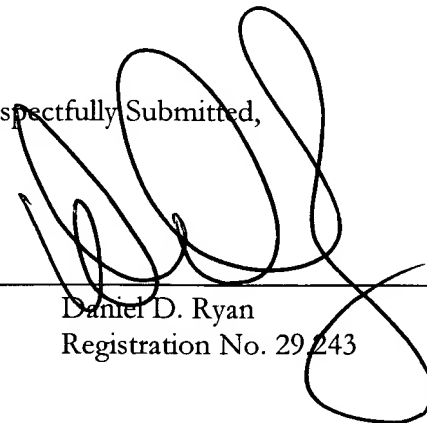
directed to inserting a bone plugging material into cortical bone either before or after the step of compacting the cancellous bone; and conveying a filling material into the cavity. The claims of neither the '691 Patent nor the '216 Patent teach or suggest a method, as defined in amended claim 1, in which a platform is positioned between an expandable structure and a first region of cancellous bone which is not to be compressed, and in which a cavity is formed in a second region of cancellous bone by expanding the expandable structure with the platform serving as a barrier to induce the expandable structure to expand away from the platform to compress the second region of the cancellous bone, while the first region of the cancellous bone remains substantially not compressed. For these reasons, applicant respectfully requests the Examiner to withdraw these obviousness type double patenting rejections.

Applicant will respond to the provisional double patenting rejections (based upon claims pending in various other applications) at the time allowable subject matter in this application is indicated, but for the double patenting rejections. At that time, the nature and status of the other claims can be ascertained with more certainty and the appropriateness of any double patenting rejection addressed.

Subject to these considerations, applicant believes claims 1; 4; 11; 12; and 23 are in condition for allowance.

Respectfully Submitted,

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